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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,940	09/27/2001	Paul Portmann	33966	2200
116	7590	03/09/2004	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			LUEBKE, RENEE S	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/964,940

Applicant(s)

PORTMANN

Examiner

Renee S. Luebke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-6,9,11,14 and 16 is/are allowed.
- 6) ☒ Claim(s) 1,2,7,10-12,15 and 17 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Based on applicant's remarks and the fees filed, it is evident that applicant intended to cancel claim 13. Therefore, even though claim 13 is present in the list of claims, it has not been examined.
2. Claim 11 is objected to because it depends on cancelled claim 8.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Gandelot. This switch comprises a metal switching element 34, contact surfaces 28 and a diaphragm 40 that butts against a housing 20, 27. The diaphragm is prestressed (at and adjacent 41) to secure the switching elements against the contact surfaces. In regard to claim 15, it is noted that the first position is seen to be the position of the switching element is seen to be the point at which it is located when electrical connection is first made. The second position is seen to be a position slightly beyond the first as continued pressing occurs. In regard to claim 17, it is noted that "rigid" is a relative term and the switching element 34 is seen to be rigid relative to the diaphragm 40.
5. Claims 1, 2, 7, 10, 12 and 11 (as dependent upon the rejected claims) are rejected under 35 U.S.C. 103(a) as being unpatentable over Gandelot. The number of contact surfaces is seen to have been an obvious matter of design choice; applicant does not indicate a particular reason for using three or four, or any other number.

In response to applicant's argument that there is no motivation to alter the contacts of Gandelot, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

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to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the addition of third, fourth, etc. contacts in a switch is well known for the purpose of controlling an additional circuit or for incremental control of a single function.

In regard to claims 2 and 10, it is noted that Gandelot does not indicate the specific plastic material for the housing 27 or the specific elastic material for the diaphragm. However, it is common to form such members from a 2-part injection molded plastic and a thermoplastic, respectively, as a matter of convenience. Therefore, it would have been obvious to form the housing and diaphragm of Robinson in this manner.

In regard to claim 11, the intended use of the switch “in miniaturized devices” does not result in a structural difference and is therefore not given patentable weight. It is further noted that a modern car is seen to be a “miniaturized” device in comparison to the cars in which Gandelot intended the switch be used.

6. Claims 4-6, 9 and 16 (and claims 11 and 14 as dependent on allowable claims) are allowed.

Claims 14/1, 14/2, 14/7 and 14/10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. It is suggested that responses to this final action be faxed to:  
(703) 872-9306

Please refrain from sending a confirmation copy, as noted in 37 CFR 1.6(d) and 1.8(b).

Alternatively, responses may be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. Renee Luebke at (571) 272-2009. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mrs. Paula Bradley, can be reached at (571) 272-2800, extension 33.



Renee S. Luebke  
Primary Patent Examiner  
March 3, 2004